

REMARKS

This Response is submitted in reply to the Final Office Action dated December 2, 2003. Claims 1, 5, 6, 7, 9, 11, 15, 17 and 25 have been amended. No new matter has been added by any of the amendments made herein. A Petition for a One-Month Extension of Time to Respond to the Office Action and a Request for Continued Examination ("RCE") are submitted herein. A check in the amount of \$880.00 is enclosed to cover the fees for the one-month extension and the RCE. Please charge deposit account no. 02-1818 for any insufficiency or to credit any overpayment.

Claims 1 to 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,491,584 to Graham et al. ("*Graham*") in view of U.S. Patent No. 6,203,429 to Demar et al. ("*Demar*").

As discussed during the telephone interview, a person of ordinary skill in the art would not be motivated to combine *Graham* and *Demar* to teach the present invention. Even if *Graham* and *Demar* were combined as suggested by the Examiner, the combination does not teach or suggest the present invention. Additionally, the claims have been amended to further clarify the present invention.

Amended Claim 1 is directed to a gaming device including a processor, a primary game controlled by the processor and a secondary game controlled by the processor. The gaming device also includes a secondary game triggering event in the primary game which triggers the secondary game. Additionally, the gaming device includes a secondary game re-triggering event in the secondary game which re-triggers the entire secondary game where the secondary game re-triggering event in the secondary game is more likely to occur in the secondary game than the secondary game triggering event in the primary game. The combination of *Graham* and *Demar* does not disclose, teach or suggest the combination of elements of Claim 1.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). Moreover, a *prima facie* case of obviousness can be rebutted if the applicant can show that the prior art teaches away from the claimed invention. *In re Haruna*, 58 U.S.P.Q.2d 1517, 1522

(Fed. Cir. 2001). A reference teaches away when a person of ordinary skill in the art, upon reading the reference, will be led in a direction “divergent from the path” that was taken by the applicant. (*Id.*)

Graham discloses a gaming machine including a base game. The gaming machine provides an initial series of free games to a player when a trigger condition occurs in the base game. (Col. 3, lines 5 to 10) The gaming machine provides a subsequent series of free games to the player if the same trigger condition occurs in the initial series of free games. The subsequent series of free games has a different bonus feature. In one embodiment, the bonus feature includes a payable having awards that are triple or three times the awards in the payable associated with the base game. Accordingly, when the same trigger condition occurs in the free games, another series of free games and a different bonus feature are provided to the player. In one embodiment, each subsequent bonus feature includes a payable having larger awards.

As described above, *Graham* does not disclose, teach or suggest increasing the frequency of the trigger condition in one or more of the free games. Rather, *Graham* teaches that:

the trigger frequency may decrease for at least some of the series of free games by changing the length or layout of the reel strips. (Col. 3, lines 59 to 61) (emphasis added).

This teaching in *Graham* would lead a person of ordinary skill in the art in a direction away from increasing the trigger frequency of the trigger condition in any of the free games from the trigger frequency of the trigger condition in the base game. Additionally, *Graham* discloses providing additional free games when the trigger condition occurs in one of the free games. However, *Graham* does not disclose, teach or suggest re-triggering the entire secondary game when the trigger condition occurs as in amended Claim 1.

During the telephone interview conducted on January 28, 2004, the Examiner stated that *Graham* teaches or suggests increasing the frequency of a retrigger in a bonus game. Specifically, the Examiner stated that the section of the specification of

Graham at column 1, line 66 to column 2, line 4 teaches or suggests this feature. This section of *Graham* is as follows:

Any suitable bonus feature may be applicable. Thus, the bonus feature may include at least one of the changes in definitions of symbol functions, for example, to scatters, substitutes, bonus symbols, feature triggers, etc., payable variations or an increase in the number of free games awarded.

Applicants respectfully disagree with the Patent Office regarding the correct interpretation of this language in *Graham*.

In *Graham*, a bonus feature is associated with the initial series of free games provided to the player when a trigger condition occurs in the base game. If during any one of the free games of the initial serial of free games, the exact same trigger condition arises, another set or series of free games are awarded to the player. A different bonus feature is associated with that series of free games. *Graham* describes the bonus feature as a payable which provides increased awards such as double the awards provided for the base game. (Col. 3, lines 11 to 21). The bonus feature is applicable to the remaining number of free games from the initial free games and all of the free games from the additional or bonus set of free games provided to the player. *Graham* describes the bonus feature as being a payable which increases for each subsequent series of free games provided to the player when a trigger condition occurs. For example, *Graham* states that if the trigger condition occurs again, the payable for all of the prizes becomes five times the awards of the payable associated with the base game. (Col. 3, lines 33 to 44).

This language in *Graham* does not disclose, teach or suggest increasing the frequency of the trigger condition in the subsequent series of free games. As described above, *Graham* discloses that the bonus feature may include at least one of a change in bonus symbols or feature triggers, but does not disclose how those symbols or triggers are changed. *Graham* does not disclose, teach or suggest increasing the likelihood of the occurrence of the feature trigger. For each of these reasons, *Graham* does not

disclose, teach or suggest increasing the likelihood of obtaining a retrigger of the entire bonus game or an additional spin in the bonus game.

Demar discloses a gaming device including a basic game and a bonus game. In the basic game, an event or sequence of outcomes occur at a low frequency or low probability. (Col. 4, lines 5 through 15) The bonus game includes a generally high hit rate or high probability of winning. (Col. 6, lines 60 through 62) In one embodiment, the bonus game has a hit rate greater than fifty percent and preferably greater than seventy percent (Col. 7, lines 38 to 41) The hit rate or probability of winning is expressed as a Bernoulli trial which is usually referred to as a "probability of success". (Col. 7, lines 47 to 54). The gaming device continues to provide Bernoulli trials to the player as long as each trial produces a winning combination. (Col. 10, lines 27 to 38). By employing a geometric functions such as the Bernoulli trials, *Demar* enables a player to accumulate more awards in the bonus game since the hit rate for the bonus game is greater than fifty percent and in some instances, greater than seventy percent. Therefore, *Demar* discloses a gaming device having a basic game and a bonus game where the hit rate in the bonus game is greater than the basic game by modifying the probability of success or the hit rate in the bonus game. The player continues to receive trials in the bonus game until a losing outcome occurs and the game ends. *Demar* does not disclose, teach or suggest a gaming device including a primary game and a secondary game where a secondary game triggering event in the primary game triggers the secondary game and a secondary game re-triggering event in the secondary game re-triggers the entire secondary game. On the contrary, *Demar* discloses employing a geometric function as a probability of success to increase the hit rate of obtaining awards in the bonus game. *Demar* does not disclose, teach or suggest providing additional trials or free games in the bonus game after the initial number of free games or trials are provided to the player in the bonus game.

As described above, *Graham* discloses a base game which, upon a trigger condition in the base game, initiates a series of free games. If the same trigger condition arises in one or more of the free games, additional free games are provided to a player. Additionally, *Graham* teaches that the trigger frequency of the trigger condition

may decrease for at least one or more of the free games. Graham also does not disclose, teach or suggest that the bonus feature increases the likelihood of obtaining the trigger condition in one or more of the free games. Thus, *Graham* teaches away from the combination of *Graham* and *Demar* suggested by the Patent Office because *Graham* teaches a bonus game where the likelihood of obtaining the trigger condition in the bonus game is the same or less likely than obtaining the trigger condition in the base game. A person of ordinary skill in the art would not be motivated to combine *Graham* and *Demar* because *Graham* teaches away from such a combination. The combination of *Graham* and *Demar* also does not disclose, teach or suggest re-triggering the entire bonus game or providing one or more additional spins of the bonus game.

For each of these reasons, the combination of *Graham* and *Demar* does not disclose, teach or suggest the elements of amended Claim 1. Therefore, amended Claim 1 and Claims 2 to 4, which depend from amended Claim 1, are patentably distinguished over the combination of *Graham* and *Demar* and are in condition for allowance.

Even if *Graham* and *Demar* were combined, the combination would not disclose, teach or suggest the elements of amended Claim 1. As described above, *Graham* discloses, teaches, or suggests employing the same trigger condition to trigger one or more series of additional free games. *Demar* discloses a bonus game having a higher hit rate or probability of obtaining an award than the base game. *Demar* does not disclose, teach or suggest increasing the probability or the hit rate of obtaining additional free games or trials in the bonus game. In fact, *Demar* discloses obtaining a number of trials or free games in the bonus game and ending the game when there are no free games remaining. *Demar* does not disclose, teach or suggest obtaining additional free games or trials in the bonus game and therefore does not disclose, teach or suggest re-triggering the entire secondary or bonus game or providing additional free games in the bonus game. Thus, the combination of *Graham* and *Demar* teaches or suggests a bonus game where the hit rate of obtaining a particular award is greater than the hit rate of obtaining that same award in the base game but does not disclose, teach

or suggest increasing the likelihood of obtaining a re-trigger of the secondary game which is greater than the likelihood of obtaining a trigger of the secondary game in the base game. For these additional reasons, the combination of *Graham* and *Demar* does not disclose, teach or suggest the elements of amended Claim 1.

Amended Claim 5 is directed to a gaming device including a processor and a display device controlled by the processor. The gaming device also includes a primary game and a secondary game where the primary game is displayed by the display device and controlled by the processor and includes at least one secondary game triggering symbol which triggers the secondary game. Specifically, the secondary game is triggered upon the display of the secondary game triggering symbol in one predetermined position in the primary game. The gaming device also includes at least one re-trigger of the entire secondary game or at least one additional spin in the secondary game provided to the player in the secondary game upon the display of one of the secondary game triggering symbols in one of the plurality of predetermined positions in the secondary game.

Amended Claim 5 includes similar elements to amended Claim 1 and additionally includes the element of triggering a secondary game when a triggering symbol occurs in one predetermined position in the primary game and re-triggering the secondary game when one of the secondary game triggering symbol occurs in one of a plurality of predetermined positions in the secondary game. Thus, the re-triggering event in the secondary game is more likely than the triggering event in the primary game because the secondary game triggering symbol or symbols may occur on more than one position in the secondary game to re-trigger the secondary game. As described above, *Graham* teaches away from employing a trigger condition which is more likely in a secondary game than in a primary game. In addition as described above, even if *Graham* and *Demar* were combined, the combination would not disclose, teach or suggest the elements of amended Claim 5. For each of these reasons, the combination of *Graham* and *Demar* does not disclose, teach or suggest the elements of amended Claim 5. Therefore, amended Claim 5 is patentably distinguished over the combination of *Graham* and *Demar* and is in condition for allowance.

Amended Claim 6 is directed to a gaming device including similar elements to amended Claims 1 and 5 where a secondary game is triggered upon the display of a predetermined combination of a plurality of secondary game triggering symbols in a primary game. In the secondary game, at least one re-trigger of the entire secondary game or at least one additional spin in the secondary game is provided to the player in the secondary game upon the display of one of the combinations in the secondary game where the display of one of the combinations in the secondary game is more likely to occur than the display of the combination in the primary game.

As described above, *Graham* teaches away from employing a trigger condition which is more likely in a secondary game than in a primary game. Also, even if *Graham* and *Demar* were combined, the combination would not disclose, teach or suggest the elements of amended Claim 6. For each of these reasons, the combination of *Graham* and *Demar* does not disclose, teach or suggest the elements of amended Claim 6. Therefore, amended Claim 6 is patentably distinguished over the combination of *Graham* and *Demar* and is in condition for allowance.

Amended Claim 7 includes similar elements to amended Claim 1 and further includes a secondary game which is triggered upon the display of a predetermined combination of a plurality of secondary game triggering symbols in the primary game and at least one re-trigger of the secondary game is provided to the player when less than the plurality of secondary game triggering symbols is displayed in the secondary game. Thus, the re-trigger of the secondary game in the secondary game is more likely than the trigger of the secondary game in the primary game because the re-triggering event requires less secondary symbols to be displayed in the secondary game than the triggering event in the primary game. As described above, *Graham* teaches away from employing a trigger condition which is more likely in a secondary game than in a primary game. In addition as described above, even if *Graham* and *Demar* were combined, the combination would not disclose, teach or suggest the elements of amended Claim 7. For each of these reasons, the combination of *Graham* and *Demar* does not disclose, teach or suggest the elements of amended Claim 7. Therefore, amended Claim 7 is

patentably distinguished over the combination of *Graham* and *Demar* and is in condition for allowance.

Claim 8 is directed to a gaming device including a processor and a display device controlled by the processor. The gaming device also includes a base game displayed by the display device and controlled by the processor where the base game includes a plurality of bonus game triggering symbols. The gaming device further includes a bonus game displayed by the display device and controlled by the processor where the bonus game is triggered upon the display of a predetermined combination of bonus triggering symbols in the base game where the predetermined combination has a likelihood of occurrence. A bonus re-trigger is provided to the player in the bonus game when a predetermined combination of the bonus triggering symbols is displayed by the display device in the bonus game where the predetermined combination has a likelihood of occurrence which is greater than the likelihood of occurrence of the predetermined combination to trigger the bonus game in the base game.

As described above, *Graham* teaches away from employing a trigger condition which is more likely in a secondary game than in a primary game. Also, even if *Graham* and *Demar* were combined, the combination would not disclose, teach or suggest the elements of amended Claim 8. For each of these reasons, the combination of *Graham* and *Demar* does not disclose, teach or suggest the elements of Claim 8. Therefore, Claim 8 and Claims 9 to 13, which depend from Claim 8, are each patentably distinguished over the combination of *Graham* and *Demar* and in condition for allowance.

Claim 14 is directed to a gaming device including a processor, a display device controlled by the processor, a base game displayed by the display device and controlled by the processor where the base game includes a plurality of bonus triggering symbols and a bonus game displayed by the display device and controlled by the processor where the bonus game is triggered upon the display of a plurality of bonus triggering symbols in the base game. The gaming device also includes a bonus re-trigger which is provided to the player in the bonus game when less than the plurality of bonus triggering symbols are displayed in the bonus game. Claim 14 includes similar elements to

amended Claim 7. Therefore, for the reasons provided above for amended Claim 7, the combination of *Graham* and *Demar* does not disclose, teach or suggest the elements of Claim 14. Therefore, Claim 14 and Claims 15 to 18, which depend from Claim 14, are each patentably distinguished over the combination of *Graham* and *Demar* and in condition for allowance.

Claim 19 is directed to a gaming device including a processor, a plurality of reels controlled by the processor and a plurality of symbols on each reel where the symbols include a plurality of secondary game triggering symbols. The gaming device also includes a primary game including at least one activation of the reels by the processor and a secondary game including at least one activation of the reels by the processor where the secondary game is triggered upon the display of a plurality of the secondary game triggering symbols on an active payline associated with the reels in the primary game. The gaming device also includes a secondary game re-trigger provided to the player in the secondary game when the plurality of secondary game triggering symbols are displayed by the reels in any position of the secondary game.

As described above, the combination of *Graham* and *Demar* does not disclose, teach or suggest increasing the likelihood of obtaining a secondary game re-trigger in a secondary game than obtaining a secondary game triggering event in the primary game by increasing the potential locations or positions that the secondary game triggering symbols may occur in the secondary game to re-trigger the secondary game. For these reasons, Claim 19 and Claims 20 to 23, which depend from Claim 19, are each patentably distinguished over the combination of *Graham* and *Demar* and are in condition for allowance.

Claim 24 is directed to a method for operating a gaming device having a primary game and a secondary game where the gaming device triggers the secondary game if a predetermined combination of the secondary game triggering symbols are obtained in the primary game and provides a secondary game re-trigger to a player in the secondary game if at least one of the secondary game triggering symbols in the primary game is displayed in the secondary game. As described above, the combination of *Graham* and *Demar* does not disclose, teach or suggest increasing the likelihood of re-

triggering a secondary game by requiring less symbols to be displayed in the secondary game to re-trigger the secondary game that the symbols required to trigger the secondary game in the primary game. For these reasons, Claim 24 and Claims 25 and 26, which depend from Claim 24, are each patentably distinguished over the combination of *Graham* and *Demar* and in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art, such action is courteously solicited. If the Patent Office has any questions regarding this Response, Applicant respectfully requests that the Patent Office contact the undersigned to discuss this Response.

Respectfully submitted,

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